

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Patent Application**

Applicant(s): Fernando Incertis Carro  
Docket No.: FR920000015US2  
Serial No.: 10/786,201  
Filing Date: February 25, 2004  
Group: 2176  
Examiner: Quoc A. Tran

Title: Method and System for Accessing Interactive Multimedia Information or Services  
by Touching Marked Items on Physical Documents

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REQUEST FOR REFUND UNDER 37 CFR §1.26

Commissioner of Patents and Trademarks  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

In accordance with 37 CFR § 1.26 and MPEP 607.02, the Applicant hereby requests a refund of the Notice of Appeal fee in the amount of \$500.00 that was charged on April 16, 2007. The Applicant hereby further requests that the refund be credited to **International Business Machines Corporation Deposit Account No. 50-0510**.

The Applicant respectfully submits that the Notice of Appeal fee should be refunded in view of the fact that the Notice of Appeal and the Pre-Appeal Brief were not filed prematurely, as alleged in the Notice of Panel Decision from Pre-Appeal Brief Review dated April 30, 2007 and the Advisory Action dated May 1, 2007.

Chronology:

January 29, 2007:

Applicants received Non-Final Office Action dated January 24, 2007 (see Attachment 1)

April 16, 2007:

Applicants submitted Notice of Appeal, Pre-Appeal Brief Request for Review and Memorandum in Support of Pre-Appeal Brief Request for Review (see Attachment 2).

May 3, 2007:

Applicants received a Notice of Panel Decision from Pre-Appeal Brief Review dated April 30, 2007 along with an Advisory Action Before the Filing of an Appeal Brief dated May 1, 2007 indicating the Notice of Appeal, Pre-Appeal Brief Request for Review and Memorandum in Support of Pre-Appeal Brief Request for Review were prematurely submitted as the claims had not been twice rejected (see Attachment 3 and 4)

As noted above, Applicant previously submitted a Memorandum in Support of Pre-Appeal Brief Request for Review dated April 16, 2007. In the Notice of Panel Decision from Pre-Appeal Brief Review dated April 30, 2007, and the Advisory Action dated May 1, 2007, the Pre-Appeal Brief Request was rejected as being premature since the claims were not twice rejected. Applicant notes, however, that the USPTO Notice dated 12 July 2005 regarding the Pre-Appeal Brief Program notes that, "under the current practice every applicant whose claims have been twice rejected may appeal the Examiner's decision to the Board of Patent Appeals and Interferences" and that "any applicant who has filed a notice of appeal" may use the Pre-Appeal Program. Regarding the filing of a Notice of Appeal, Chapter 1204 of the MPEP notes that, "if any claim was rejected in a parent application, and the claim is again rejected in a continuing application, then applicant can choose to file an appeal in the continuing application, even if the claim was rejected only once in the continuing application." Applicant notes that the claims of the present application were previously rejected in a parent application (United States Patent Application No. 09/782,144). Thus, Applicant maintains that the cited Notice of Appeal and Pre-Appeal Brief were not pre-mature. Applicant is also submitting herewith a Response to Office Action to expedite prosecution of the application.

The attention to this matter is greatly appreciated. Please direct any questions regarding this submission of this refund request to the undersigned attorney at the telephone number indicated below.

Respectfully,



Date: June 18, 2007

Kevin M. Mason  
Attorney for Applicants  
Reg. No. 36,597  
Ryan, Mason & Lewis, LLP  
1300 Post Road, Suite 205  
Fairfield, CT 06430  
(203) 255-6560



## UNITED STATES PATENT AND TRADEMARK OFFICE

ATTACHMENT 1

15W-147 CON

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
10/786,201	02/25/2004	Fernando Incertis Carr	FR920000015US2	3700

7590 01/24/2007  
Ryan, Mason & Lewis, LLP  
Suite 205  
1300 Post Road  
Fairfield, CT 06824

RECEIVED  
JAN 29 2007

EXAMINER  
TRAN QUOC A

ART UNIT PAPER NUMBER  
2176

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/24/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

DOCKETED
RECEIVED: 1/29/07
DUE: 4/24/07
BY: [Signature]

Non-final

7/24/07 6 Month

# Office Action Summary

Application No.

10/786,201

Applicant(s)

CARRO, FERNANDO INCERTIS

Examiner

Tran A. Quoc

Art Unit

2176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 25 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☒ Certified copies of the priority documents have been received in Application No. EP00480036.3 04-26-

2000

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 2-25-04

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

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### DETAILED ACTION

1. This is a **Non-Final** rejection in response to application filed 02-25-2004.
2. Claims 1-23 are pending in the case. Claims 1, 10, 12, 13, 20, and 23 are independent claims
3. Priority dated 04-26-2000.

### *Claim Rejections - 35 USC § 103*

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

*(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.*

5. Claims 1-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Robinson et al., *A framework for interacting with paper*, Eurographics '97, Volume 16, Number 3 – [[www.cl.cam.ac.uk/Research/Origami/Origami1997c/index.html](http://www.cl.cam.ac.uk/Research/Origami/Origami1997c/index.html)] (hereinafter Robison) in view of Moran et al., US 6,326,946 B1 filed 09/17/1998 (hereinafter Moran).

Regarding independent claim 1, Robinson teaches a user system connected to a communication network comprising one or more servers. Specifically, Robinson discloses user interfaces for computer systems (Robinson the Abstract), and in (Robinson sections 3, 4 4 and 7).

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Also, Robinson teaches **identifying a physical document, the physical document comprising one or identifying a page of the physical document**. Specifically, Robinson discloses a method of marking the paper documents with a unique identifier (Robinson Section 2-para 5).

In addition, Robinson teaches **identifying the selected marked item by referring to a hyperlink table, the hyperlink table comprising an indication of a position of each marked item on the identified page; identifying information or a service associated with the selected marked item by referring to the hyperlink table, the hyperlink table comprising, for each marked item of each page of the document, identification on a server of the information or the service associated with the selected marked item; and accessing the information or the service associated with the selected marked item**. Specifically, Robinson discloses a method of marking the paper documents with a unique identifier, wherein other forms of hypertext can be absorbed into the animated paper document system for importing and exporting. The links is associated with web paper in the Registry, the page can be printed on paper, and links activated by placing the paper on a DigitalDesk and pointing for importing/exporting (Robinson sections 4, 4.1, and 4.4.).

Furthermore, Robison does not teach, but Moran teaches **determining a position of a point pressed on a touch foil, the touch foil being placed and aligned over or under the identified page of the physical document, the identified page comprising one or more marked items, and the touch foil being pressed at a point corresponding to a selected marked item**. Specifically, Moran discloses determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in

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(Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks. It also would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents.

**Regarding dependent claim 2, Robinson teaches accessing a hyperlink table associated with an identified physical document (Robinson sections 4.1 and 4.4).**

**Regarding dependent claim 3, Robinson teaches determining a destination address in the communications network where the information or service associated with the selected marked item can be accessed (Robinson sections 4.4 and 7)**

**Regarding dependent claim 4, Robinson teaches an Internet Protocol communications network, servers which are Web servers, a user system comprising Web browsers, a destination address which is a Uniform Resource Locator, and that the information or service comprises at least one Web page (Robinson sections 3, 4.4, and 7).**

Robinson uses mostly commodity hardware and the registry and adaptors are written to work as a distributed system. Commodity hardware forming a distributed system may inherently use Internet Protocol, Web servers, Uniform Resource Locators, a user system comprising Web browsers, and information and services contained on web pages because those are all standards

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of geographically dispersed networking and one of ordinary skill in the art would have wanted to utilize standard equipment to create a cost effective and compatible system.

**Regarding dependent claim 5**, Robinson teaches **wherein the physical document has a form and comprises a physical surface and a material, wherein the physical surface comprises an engraved, a printed, a painted, or a written surface, wherein the material comprises paper, wood, or plastic, and wherein the form comprises a newspaper, magazine, book, catalog, geographical map, photograph, or painting**. Specifically, Robinson disclose in the abstract that the physical document comprises a physical surface made of paper on which is printed ink (Robinson the Abstract).

**Regarding dependent claim 6**, Robinson teaches **wherein a marked item on a physical document comprises a word, a letter, an icon, a graphic, a symbol, or a mark**. Specifically, Robinson discloses mark the paper with a reference (Robison Section 2). Moran also teaches this in the abstract

**Regarding dependent claim 7**, Robinson teaches in section 4 4 that the hyperlink table comprises **additional information which may be accessed** and which may include a title, an author, and a date.

**Regarding dependent claim 8**, Robinson teaches in section 2 that **the physical document comprises a plurality of pages and that the identified page is one page of the plurality of pages**.

**Regarding dependent claim 9**, Robinson does not teach, but Moran does teach **a touch foil sensitive to pressure exercised over any point** in (Moran col. 6 lines 13-19).



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It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran with Robinson to create the claimed invention. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks.

**Regarding independent claim 10**, the rejection of claim 1 is fully incorporated. In addition, **a user system** embodied therein for performance the method of claim 1. Specifically, Robinson discloses user interfaces for computer systems (Robinson the Abstract)

Also, Robinson teaches **a means for identifying a marked item by referring to a hyperlink table, identifying information associated with the selected marked item by referring to the hyperlink table, and accessing the information associated with the selected marked item** in (Robinson section 4.1)

In addition, Robinson does not teach, but Moran teaches **a means for determining a position of a point pressed on a touch foil, the touch foil being placed and aligned over or under the identified page of the physical document or identifying and accessing a service associated with the selected marked item**. Specifically, Moran discloses a means for determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have

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been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks. It also would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents.

**Regarding dependent claim 11**, Robinson teaches **a user system connected to a communication network comprising one or more servers** in (Robinson sections 3, 4.4 and 7).

In addition, Robinson does not teach, but Moran teaches is **a transmitting means between the touch foil and the user system for transmitting the position of the points pressed on the touch foil**. Specifically Moran discloses a transmitting means between the touch foil and the user system for transmitting the position of the points pressed on the touch foil in (Moran col. 6 lines 13-34).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran with Robinson to create the claimed invention. It would be inherently necessary to create a communication link between the touch foil and the user system for the touch foil taught by Moran to be useful

**Regarding independent claim 12**, the rejection of claim 1 is fully incorporated.

In addition, **a computer program on a computer readable medium** embodied therein for performance the method of claim 1. Specifically, Robinson discloses a high-level systems programming language that particularly lends itself to operation in a distributed environment (Robinson section 2).

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Also, Robinson teaches **steps for identifying a marked item by referring to a hyperlink table, identifying information associated with the selected marked item by referring to the hyperlink table, and accessing the information associated with the selected marked item** in (Robinson section 4.1).

In addition, Robinson does not teach, but Moran teaches **steps for determining a position of a point pressed on a touch foil, the touch foil being placed and aligned over or under the identified page of the physical document or identifying and accessing a service associated with the selected marked item**. Specifically, Moran discloses a means for determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 -- col. 3 line 3)

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks. It also would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents.

**Regarding independent claim 13**, the rejection of claim 1 is fully incorporated. In addition, Robinson teaches **storing in the hyperlink table an identification of the physical document for each page of the physical document; storing in the hyperlink table an**

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**identification of the identified page; storing in the hyperlink table an identification within the communication network of information or a service associated with each marked item; and storing, in the hyperlink table, positions of points corresponding to marked items, the hyperlink table comprising, for each marked item, an indication of its position on the identified page.** Specifically, Robinson discloses a method of marking the paper documents with a unique identifier, wherein other forms of hypertext can be absorbed into the animated paper document system for importing and exporting. The links is associated with web paper in the Registry, the page can be printed on paper, and links activated by placing the paper on a DigitalDesk and pointing for importing/exporting (Robinson sections 4, 4.1, and 4.4.), and Robison discloses the registry provides the central directory service for animated paper documents. It stores the image of each active document and the code of any interactors, together with cross-references between these and indexes to identify them (Robinson section 3).

**Regarding dependent claim 14, Robinson teaches in section 4.4 storing a destination address in the communication network where information associated with a selected marked item can be accessed.**

In addition, Robinson does not teach, but Moran teaches **the service associated with a selected marked item**. Specifically, Moran discloses service associated with a selected marked item (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents.

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**Regarding dependent claim 15, Robinson teaches an Internet Protocol communications network, servers which are Web servers, a user system comprising Web browsers, a destination address which is a Uniform Resource Locator, and that the information or service comprises at least one Web page in (Robinson sections 3, 4.4, and 7).** Robinson uses mostly commodity hardware and the registry and adaptors are written to work as a distributed system. Commodity hardware forming a distributed system inherently uses Internet Protocol, Web servers, Uniform Resource Locators, a user system comprising Web browsers, and information and services contained on web pages because those are all standards of geographically dispersed networking and one of ordinary skill in the art would have wanted to utilize standard equipment to create a cost effective and compatible system.

**Regarding dependent claim 16, Robinson teaches wherein the physical document has a form and comprises a physical surface and a material, wherein the physical surface comprises an engraved, a printed, a painted, or a written surface, wherein the material comprises paper, wood, or plastic, and wherein the form comprises a newspaper, magazine, book, catalog, geographical map, photograph, or painting.** Specifically, Robinson disclose in the abstract that the physical document comprises a physical surface made of paper on which is printed ink (Robinson the Abstract).

**Regarding dependent claim 17, Robinson teaches wherein a marked item on a physical document comprises a word, a letter, an icon, a graphic, a symbol, or a mark.** Specifically, Robinson discloses mark the paper with a reference (Robison Section 2). Moran also teaches this in the abstract.

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**Regarding dependent claim 18**, Robinson teaches **storing in the hyperlink table additional information related document, the additional information comprising a title, an author, and a date**. For example, Robison discloses the registry provides the central directory service for animated paper documents. It stores the image of each active document and the code of any interactors, together with cross-references between these and indexes to identify them (Robinson section 3).

**Regarding dependent claim 19**, Robinson teaches in the abstract and section 2 that **the physical document comprises a plurality of pages and wherein the identified page is one page of the plurality of pages**

**Regarding independent claim 20**, the rejection of claim 13 is fully incorporated. In addition, **a user system** embodied therein for performance the method of claim 13. Specifically, Robinson discloses user interfaces for computer systems (Robinson the Abstract).

**Regarding independent claim 21**, Robinson teaches **the user system is connected to a communication network comprising one or a plurality of servers** (Robinson sections 3, 4 4, and 7). Robinson uses mostly commodity hardware and the registry and adaptors are written to work as a distributed system. Commodity hardware forming a distributed system may inherently use Internet Protocol, Web servers, Uniform Resource Locators, a user system comprising Web browsers, and information and services contained on web pages because those are all standards of geographically dispersed networking and one of ordinary skill in the art would have wanted to utilize standard equipment to create a cost effective and compatible system.

In addition, Robinson does not teach, but Moran teaches **s a transmitting means between the touch foil and the user system for transmitting the position of the points**

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**pressed on the touch foil** Specifically, Moran discloses a means for determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-19) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 – col. 3 line 3).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Moran into Robinson to create the invention as claimed. It would have been obvious and desirable to use a touch foil to locate electronically the marked positions on the paper because the touch foil can achieve a high degree of accuracy in determining the positions of the marks. It also would have been obvious and desirable to associate digital services with the marks in addition to information in order to add more features to help the users draft, modify and annotate their documents.

**Regarding dependent claim 22**, Robinson does not teach, but Moran teaches **s a wherein the touch foil comprises a transparent touch foil, the touch foil being placed and aligned over the identified page of the physical document**. Specifically, Moran discloses a means for determining a position of a point pressed on a touch foil which is placed and aligned over or under the identified page of the physical document in (Moran col. 6 lines 13-14) and identifying and accessing a service associated with a selected marked item in (Moran col. 2 line 50 – col. 3 line 3). It would be inherently necessary to create a communication link between the touch foil and the user system for the touch foil taught by Moran to be useful.

**Regarding independent claim 23**, the rejection of claim 13 is fully incorporated. In addition, **a computer program stored on a computer readable medium** embodied therein for performance the method of claim 13. Specifically, Robinson discloses user interfaces for

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computer systems (Robinson the Abstract), and Robinson discloses a high-level systems programming language that particularly lends itself to operation in a distributed environment (Robinson section 2).

*Conclusion*

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.


Schena et al                      US 6,448,979                      issued 09-2002

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quoc A. Tran whose telephone number is 571-272-8664. The examiner can normally be reached on 9AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Herndon R. Heather can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is (571)-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Quoc A. Tran - 1-19-2007  
GAU 2176

  
Heather R. Herndon  
Supervisory Patent Examiner  
Technology Center 2100



2/25/04

FORM PTO-1449 (MODIFIED)

Applicant: Fernando Incertis Carro  
Docket No.: FR920000015US2  
Serial No.: Unassigned  
Filing Date: Concurrently Herewith  
Group: Unassigned

LIST OF PUBLICATIONS FOR  
APPLICANT'S INFORMATION  
DISCLOSURE STATEMENT

U.S. PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NO.	DATE	NAME	CLASS/SUBCLASS	FILING DATE IF APPROPRIATE
QT	5,692,073	11/25/97	Cass	382/219	
	6,081,261	06/27/00	Wolff et al.	345/179	
	6,326,946	12/04/01	Moran et al	345/156	
	6,330,976	12/18/01	Dymetman et al.	235/487	
	6,356,923	03/12/02	Yano et al.	707/513	

FOREIGN PATENT DOCUMENTS

EXAMINER INITIAL	DOCUMENT NO.	DATE	COUNTRY	CLASS/SUBCLASS	TRANSLATION	
					YES	NO

OTHER DOCUMENTS

EXAMINER INITIAL	REF NO.	AUTHOR, TITLE, DATE, PERTINENT PAGES, ETC.
QT		Meyer, A., "Pen Computing: A Technology Overview and a Vision," ACM SIGCHI Bulletin, Vol. 27, No 3, pgs. 46-90 (July 1995).
QT		Robinson et al., "A Framework for Interacting with Paper," EUROGRAPHICS, Vol 16, No. 3, pgs 1-10 (1997).

/Quoc Tran/

01/19/2007

Examiner

Date Considered

Examiner: Initial if reference considered, whether or not citation is in conformance with MPEP 609; draw line through citation if not in conformance and not considered. Include copy of this form with next communication to Applicant.

**Notice of References Cited**Application/Control No  
10/786,201Applicant(s)/Patent Under  
Reexamination  
CARRO, FERNANDO INCERTISExaminer  
Tran A. QuocArt Unit  
2176

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**U.S. PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Name	Classification
*	A	US-6,326,946 B1	12-2001	Moran et al.	345/156
*	B	US-6,448,979	09-2002	Schena et al.	715/741
	C	US-			
	D	US-			
	E	US-			
	F	US-			
	G	US-			
	H	US-			
	I	US-			
	J	US-			
	K	US-			
	L	US-			
	M	US-			

**FOREIGN PATENT DOCUMENTS**

*		Document Number Country Code-Number-Kind Code	Date MM-YYYY	Country	Name	Classification
	N					
	O					
	P					
	Q					
	R					
	S					
	T					

**NON-PATENT DOCUMENTS**

*		Include as applicable: Author, Title Date, Publisher, Edition or Volume, Pertinent Pages)
	U	Robinson et al. <a href="http://www.cl.cam.ac.uk/research/origami/Origami1997c/index.html">http://www.cl.cam.ac.uk/research/origami/Origami1997c/index.html</a> ; published November 1997 pages 1-9
	V	
	W	
	X	

\*A copy of this reference is not being furnished with this Office action. (See MPEP § 707.05(a))  
Dates in MM-YYYY format are publication dates. Classifications may be US or foreign.

## Electronic Acknowledgement Receipt

<b>EFS ID:</b>	1686013
<b>Application Number:</b>	10786201
<b>International Application Number:</b>	
<b>Confirmation Number:</b>	3700
<b>Title of Invention:</b>	Method and system for accessing interactive multimedia information or services by touching marked items on physical documents
<b>First Named Inventor/Applicant Name:</b>	Fernando Incertis Carro
<b>Correspondence Address:</b>	Ryan, Mason & Lewis, LLP - Suite 205 1300 Post Road Fairfield CT 06824 US 2032556560 -
<b>Filer:</b>	Kevin M. Mason
<b>Filer Authorized By:</b>	
<b>Attorney Docket Number:</b>	FR920000015US2
<b>Receipt Date:</b>	16-APR-2007
<b>Filing Date:</b>	25-FEB-2004
<b>Time Stamp:</b>	16:02:57
<b>Application Type:</b>	Utility

### Payment information:

Submitted with Payment	yes
Payment was successfully received in RAM	\$ 500
RAM confirmation Number	306

Deposit Account	500510
The Director of the USPTO is hereby authorized to charge indicated fees and credit any overpayment as follows: Charge any Additional Fees required under 37 C.F.R. Section 1.16 and 1.17	

### File Listing:

Document Number	Document Description	File Name	File Size(Bytes)	Multi Part /.zip	Pages (if appl.)
1		FR920000015US2_NOA_Pre-ApplBrief_4-16-07.pdf	404626	yes	7
<b>Multipart Description/PDF files in .zip description</b>					
<b>Document Description</b>			<b>Start</b>	<b>End</b>	
Notice of Appeal Filed			1	1	
Pre-Brief Conference request			2	7	

### Warnings:

### Information:

2	Fee Worksheet (PTO-06)	fee-info.pdf	8203	no	2
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### Warnings:

### Information:

<b>Total Files Size (in bytes):</b>	412829
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This Acknowledgement Receipt evidences receipt on the noted date by the USPTO of the indicated documents, characterized by the applicant, and including page counts, where applicable. It serves as evidence of receipt similar to a Post Card, as described in MPEP 503.

### New Applications Under 35 U.S.C. 111

If a new application is being filed and the application includes the necessary components for a filing date (see 37 CFR 1.53(b)-(d) and MPEP 506), a Filing Receipt (37 CFR 1.54) will be issued in due course and the date shown on this Acknowledgement Receipt will establish the filing date of the application.

### National Stage of an International Application under 35 U.S.C. 371

If a timely submission to enter the national stage of an international application is compliant with the conditions of 35 U.S.C. 371 and other applicable requirements a Form PCT/DO/EO/903 indicating acceptance of the application as a national stage submission under 35 U.S.C. 371 will be issued in addition to the Filing Receipt, in due course.

### New International Application Filed with the USPTO as a Receiving Office

If a new international application is being filed and the international application includes the necessary components for an international filing date (see PCT Article 11 and MPEP 1810), a Notification of the International Application Number and of the International Filing Date (Form PCT/RO/105) will be issued in due course, subject to prescriptions concerning national security, and the date shown on this Acknowledgement Receipt will establish the international filing date of the application.

## Electronic Patent Application Fee Transmittal

Application Number:	10786201			
Filing Date:	25-Feb-2004			
Title of Invention:	Method and system for accessing interactive multimedia information or services by touching marked items on physical documents			
First Named Inventor/Applicant Name:	Fernando Incertis Carro			
Filer:	Kevin M. Mason			
Attorney Docket Number:	FR920000015US2			
Filed as Large Entity				
<b>Utility Filing Fees</b>				
Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Basic Filing:				
Pages:				
Claims:				
Miscellaneous-Filing:				
Petition:				
Patent-Appeals-and-Interference:				
Notice of appeal	1401	1	500	500
Post-Allowance-and-Post-Issuance:				
Extension-of-Time:				

Description	Fee Code	Quantity	Amount	Sub-Total in USD(\$)
Miscellaneous:				
Total in USD (\$)				500

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

<b>NOTICE OF APPEAL FROM THE EXAMINER TO THE BOARD OF PATENT APPEALS AND INTERFERENCES</b>		Docket Number (Optional) <b>FR920000015US2</b>					
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Assistant Commissioner for Patents Washington D C 20231" on _____  Signature _____ Typed or printed name _____		In re Application of <b>Fernando Incertis Carro</b> <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%; padding: 2px;">Application Number <b>10/786,201</b></td> <td style="width: 50%; padding: 2px;">Filed <b>February 25, 2004</b></td> </tr> </table> For Method and System for Accessing Interactive Multimedia Information or Services by Touching Marked Items on Physical Documents <table border="1" style="width: 100%; border-collapse: collapse;"> <tr> <td style="width: 50%; padding: 2px;">Group Art Unit <b>2176</b></td> <td style="width: 50%; padding: 2px;">Examiner <b>Quoc A. Tran</b></td> </tr> </table>		Application Number <b>10/786,201</b>	Filed <b>February 25, 2004</b>	Group Art Unit <b>2176</b>	Examiner <b>Quoc A. Tran</b>
Application Number <b>10/786,201</b>	Filed <b>February 25, 2004</b>						
Group Art Unit <b>2176</b>	Examiner <b>Quoc A. Tran</b>						

Applicant hereby **appeals** to the Board of Patent Appeals and Interferences from the last decision of the examiner.

The fee for this Notice of Appeal is (37 CFR 1.17(b)) \$ 500.00

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee shown above is reduced by half, and the resulting fee is: \$ \_\_\_\_\_

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Commissioner has already been authorized to charge fees in this application to a Deposit Account. I have enclosed a duplicate copy of this sheet.

☒ The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment to Deposit Account No 50-0510. I have enclosed a duplicate copy of this sheet.

☐ A petition for an extension of time under 37 CFR 1.136(a) (PTO/SB/22) is enclosed.

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

I am the

☐ applicant/inventor. Kevin M. Mason  
Signature

☐ assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record Kevin M. Mason  
Typed or printed name

☐ attorney or agent acting under 37 CFR 1.34(a).  
Registration number if acting under 37 CFR 1.34(a) \_\_\_\_\_ April 16, 2007  
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below\*.

☐ \*Total of \_\_\_\_\_ forms are submitted.

Burden Hour Statement: This form is estimated to take 0.2 hours to complete. Time will vary depending upon the needs of the individual case. Any comments on the amount of time you are required to complete this form should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, Washington, DC 20231. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Assistant Commissioner for Patents, Washington, DC 20231

Doc Code: AP PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x OMB 0651-00xx  
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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
		PR20000015US2	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents P O Box 1450 Alexandria VA 22313-1450" [37 CFR 1.8(a)]  on _____  Signature _____  Typed or printed name _____	Application Number	Filed	
	10/786,201	2/25/04	
	First Named Inventor		
	Fernando Incertis Carro		
	Art Unit	Examiner	
	2176	Quoc A. Tran	
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the		<u>Kevin M. Mason</u> Signature	
<input type="checkbox"/> applicant/inventor		<u>Kevin M. Mason</u> Typed or printed name	
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/98)		<u>(203) 255-6560</u> Telephone number	
<input checked="" type="checkbox"/> attorney or agent of record Registration number <u>36,597</u>		<u>April 16, 2007</u> Date	
<input type="checkbox"/> attorney or agent acting under 37 CFR 1.34 Registration number if acting under 37 CFR 1.34 _____			
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
<input type="checkbox"/> *Total of _____ forms are submitted.			

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P O Box 1450, Alexandria, VA 22313-1450

If you need assistance in completing the form call 1-800-PTO-9199 and select option 2



**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

**Patent Application**

5 Applicant(s): Fernando Incertis Carro  
Docket No : FR920000015US2  
Serial No.: 10/786,201  
Filing Date: February 25, 2004  
10 Group: 2176  
Examiner: Quoc A. Tran  
  
Title: Method and System for Accessing Interactive Multimedia  
Information or Services by Touching Marked Items on Physical  
15 Documents

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MEMORANDUM IN SUPPORT OF  
PRE-APPEAL BRIEF REQUEST FOR REVIEW

20 The present invention and prior art have been summarized in Applicant's  
prior responses. Claims 1-23 are presently pending in the above-identified patent  
application.

25 STATEMENT OF GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

Claims 1, 10, 12, 13, 20, and 23 are independent claims. Claims 1-23 are  
rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson et al. (hereinafter,  
Robinson), "A Framework for Interacting with Paper," Eurographics 1997, Volume 16,  
Number 3 in view of Moran et al. (United States Patent Number 6,326,946 B1;  
30 hereinafter, Moran)

ARGUMENTS

Rejection of Independent Claims 1, 10, 12, 13, 20 and 23

Independent claims 1, 10, 12, 13, 20, and 23 were rejected under 35  
35 U.S.C. §103(a) as being unpatentable over Robinson in view of Moran. Regarding claim  
1, the Examiner acknowledges that Robinson does not teach, but asserts that Moran  
teaches, "determining a position of a point pressed on a touch foil, the touch foil being

placed and aligned over or under the identified page of the physical document” (col. 6, lines 13-19) and identifying and accessing a service with a selected marked item (col. 2, line 50, to col. 3, line 3).

Each of Applicant’s independent claims requires the limitations of  
5 determining a position of a point pressed on a touch foil, the touch foil being placed and aligned over or under the identified page of the physical document, the identified page comprising one or more marked items, and the touch foil being pressed at a point corresponding to a selected marked item.

Applicant notes that Moran is directed to a physical information collage  
10 composed of components, such as documents, and operator icons “which may be used to provide digital services.” See, for instance, Abstract of Moran. While a document may be identified by the system as an object to operate on, Moran does *not* teach that an *item within the document* can be identified and/or used by the system as an operator icon. The Examiner points to col. 5, line 16, for the assertion that “Moran shows that individual  
15 textual material and graphics, which are the main components of a document, may be selected.” In the cited text (col. 5, lines 10-29), Moran text states the following:

Collage components can include physical artifacts 32  
positioned at defined spatial locations on the surface 30 (board 31 as  
shown). Physical artifacts 32 are typically documents 40 that may include  
20 but are not limited to paper based textual documents 41, small electronic display screens 36, or textual material 46 or graphical material 47 written directly on surface 30. Physical artifacts may also include wall mounted containers 38 having signaling lights 39, or attachable symbolic icons such as arrow 42. As will be appreciated, physical artifacts 32 typically include  
25 the various documents, notecards, calendars, task schedules, phone number lists, project proposals, informational flyers, meeting announcements, photographs, maps, keys, or magnetic icons commonly used to organize or disseminate information for individuals or groups. The physical artifacts can be permanently or detachably affixed by pins,  
30 clips, adhesives, strings, or other fixatives to the surface 30, or may be simply rest upon the surface 30 in suitable embodiments (e.g. a tabletop surface).

Applicant reads this cited text in Moran as indicating that textual material or graphical material can be a physical artifact, but Applicant submits that there is no indication in the  
35 cited text that items within a physical artifact can be used. Even if Moran can be considered to use a touch foil (and Applicant submits Moran does *not* disclose a touch

foil), Moran appears to determine position of physical artifacts 32 on the surface 30. By contrast, the present invention is directed toward determining marked items within identified pages of identified physical documents.

Furthermore, Applicant's independent claims require "the touch foil being placed *and aligned* over or under the identified page of the physical document." In Moran, a user can move any physical artifact 32 to any position. Applicant respectfully submits that whatever "alignment" exists in Moran for a particular physical artifact 32 would be incorrect as soon as the document is moved, and Moran appears not to place any restrictions on movement of physical artifacts 32. In fact, Applicant respectfully submits that there is no alignment required in Moran between a touch foil and an identified page of a physical document. Conversely, Applicant's independent claims require that a touch foil is aligned over or under an identified page of the physical document.

Because neither Robinson nor Moran disclose the limitations of "determining a position of a point pressed on a touch foil, the touch foil being placed and aligned over or under the identified page of the physical document, the identified page comprising one or more marked items, and the touch foil being pressed at a point corresponding to a selected marked item," Applicant respectfully submits independent claims 1, 10, 12, 13, 20, and 23 are patentable over Robinson or Moran, alone or in combination.

Additionally, Applicant respectfully submits that one skilled in the art would *not* combine Robinson and Moran. Applicant's independent claims have limitations of identifying a selected marked item of an identified page of a physical document by referring to a hyperlink table. Regarding hyperlinks, Moran states the following (col. 7, line 57 to col. 8, line 5 of Moran):

To better illustrate operation of the present invention, consider an example scenario in which a team needs to review a web site they are constructing. To provide visual, readily alterable feedback, the team prints out 12x9 inch paper sheets illustrating pages from the web site. These are tacked on a wall to form an information collage board 31 such as discussed in connection with FIG. 1. The sheets are identified by cameras positioned near the board. *To make hypertext links, the team can use tack and strings to indicate hyperlinks* During team discussions, it is decided to alter the link structure and add a couple of new pages. The tack

held strings are moved to indicate the link changes, while a couple of blank cards are tacked up to represent the new pages, with the content of those pages scribbled on the blank cards. String links to them are made to tie them into the web site.

5 As the cited text indicates, Moran teaches to use *tack and strings* to indicate *hyperlinks* as opposed to identifying a selected marked item of an identified page of a physical document by referring to a hyperlink table. For sake of argument, even if Robison teaches of using hypertext or hyperlinks in reference to a "selected item of an identified page of a physical document," Moran teaches completely different techniques for indicating and using hyperlinks. Therefore, one skilled in the art would not be motivated to combine Robinson and Moran.

10 Applicant respectfully submits that independent claims 1, 10, 12, 13, 20, and 23 are patentable over Robinson or Moran, alone or in combination, and requests the rejection of the independent claims under 35 U.S.C. §103(a) be withdrawn.

Claims 9 and 22

15 Claims 9 and 22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson et al. in view of Moran et al. Regarding claim 9, the Examiner acknowledges that Robinson does not teach, but asserts that Moran does teach, "a touch foil sensitive to pressure exercised over any point" (col. 6, lines 13-19).

20 Applicants note that claims 9 and 22 require wherein the touch foil comprises a transparent touch foil, the touch foil being placed and aligned over the identified page of the physical document. As noted above, Applicant submits that Moran does *not* disclose a touch foil, and Applicant respectfully submits that there is *no* alignment required in Moran between a touch foil and an identified page of a physical document. Applicant also finds *no* disclosure or suggestion in Moran of a *transparent touch foil*.

25 Thus, Robinson or Moran, alone or in combination, do not disclose or suggest wherein the touch foil comprises a transparent touch foil, the touch foil being placed and aligned over the identified page of the physical document, as required by claims 9 and 22.

Dependent Claims 2-9, 11, 14-19 and 21-22

Dependent claims 2-9, 11, 14-19, and 21-22 were rejected under 35 U.S.C. §103(a) as being unpatentable over Robinson et al. in view of Moran et al.

5      Claims 2-9, 11, 14-19, and 21-22 are dependent on independent claims 1, 10, 13, and 20, respectively. The dependent claims incorporate all elements of the independent claims from which they depend and are therefore patentably distinguished over Robinson and Moran (alone or in combination) for the reasons set forth above, as well as other elements these claims add in combination to their respective base claims.

10      All of the pending claims, i.e., claims 1-23, are in condition for allowance and such favorable action is earnestly solicited.

If any outstanding issues remain, or if the Examiner has any further suggestions for expediting allowance of this application, the Examiner is invited to contact the undersigned at the telephone number indicated below.

The Examiner's attention to this matter is appreciated.

15

Respectfully submitted,



Date: April 16, 2007

Kevin M. Mason

Attorney for Applicants

Reg. No. 36,597

Ryan, Mason & Lewis, LLP

1300 Post Road, Suite 205

Fairfield, CT 06824

(203) 255-6560

20



## UNITED STATES PATENT AND TRADEMARK OFFICE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO	CONFIRMATION NO
10/786,201	02/25/2004	Fernando Incertis Carro	FR920000015US2	3700

7590 04/30/2007  
 Ryan, Mason & Lewis, LLP  
 Suite 205  
 1300 Post Road  
 Fairfield, CT 06824

RECEIVED  
 MAY 03 2007

EXAMINER
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TRAN QUOC A

ART UNIT	PAPER NUMBER
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2176

MAIL DATE	DELIVERY MODE
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04/30/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

DOCKETED
RECEIVED: 5/3/07
DUE: NO ACTION
BY: [Signature]

<b>Application Number</b> 	<b>Application/Control No.</b> 10/786,201	<b>Applicant(s)/Patent under Reexamination</b> CARRO, FERNANDO INCERTIS	
	Quoc A. Tran	<b>Art Unit</b> 2176	
<b>Document Code - AP.PRE.DEF</b>			

## Notice of Panel Decision from Pre-Appeal Brief Review



This is in response to the Pre-Appeal Brief Request for Review filed 4/16/07.

1. ☒ **Improper Request** – The Request is improper and a conference will not be held for the following reason(s):

- ☐ The Notice of Appeal has not been filed concurrent with the Pre-Appeal Brief Request.
- ☐ The request does not include reasons why a review is appropriate
- ☐ A proposed amendment is included with the Pre-Appeal Brief request.
- ☒ Other: The request is pre-mature The claims have not been twice rejected.

The time period for filing a response continues to run from the receipt date of the Notice of Appeal or from the mail date of the last Office communication, if no Notice of Appeal has been received.

2. ☐ **Proceed to Board of Patent Appeals and Interferences** – A Pre-Appeal Brief conference has been held. The application remains under appeal because there is at least one actual issue for appeal. Applicant is required to submit an appeal brief in accordance with 37 CFR 41.37. The time period for filing an appeal brief will be reset to be one month from mailing this decision, or the balance of the two-month time period running from the receipt of the notice of appeal, whichever is greater. Further, the time period for filing of the appeal brief is extendible under 37 CFR 1.136 based upon the mail date of this decision or the receipt date of the notice of appeal, as applicable.

☐ The panel has determined the status of the claim(s) is as follows:  
 Claim(s) allowed: \_\_\_\_\_  
 Claim(s) objected to: \_\_\_\_\_  
 Claim(s) rejected: \_\_\_\_\_  
 Claim(s) withdrawn from consideration: \_\_\_\_\_

3. ☐ **Allowable application** – A conference has been held. The rejection is withdrawn and a Notice of Allowance will be mailed. Prosecution on the merits remains closed. No further action is required by applicant at this time.

4. ☐ **Reopen Prosecution** – A conference has been held. The rejection is withdrawn and a new Office action will be mailed. No further action is required by applicant at this time.

All participants:

(1) Quoc A. Tran

(2) Heather Herndon

  
**Lynne H. Browne**  
 Appeal Specialist, TQAS  
 Technology Center 2100  
 (3) Lynne H Browne  
 (4) \_\_\_\_\_



UNITED STATES PATENT AND TRADEMARK OFFICE

ATTACHMENT 4

182V-147 (ON)

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
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APPLICATION NO	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO
10/786,201	02/25/2004	Fernando Incertis Carro	FR920000015US2	3700

EXAMINER	
TRAN QUOC A	

ART UNIT	PAPER NUMBER
2176	

MAIL DATE	DELIVERY MODE
05/01/2007	PAPER

7590 05/01/2007  
Ryan, Mason & Lewis, LLP  
Suite 205  
1300 Post Road  
Fairfield, CT 06824

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

**DOCKETED**

RECEIVED: 5/3/07

DUE: 6/16/07

BY: [Signature]

Appeal  
Brief



**Advisory Action  
Before the Filing of an Appeal Brief**

Application No.

10/786,201

Applicant(s)

CARRO, FERNANDO INCERTIS

Examiner

Tran A. Quoc

Art Unit

2176

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 27 April 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection  
Examiner Note: If box 1 is checked, check either box (a) or (b) ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 04-16-2007. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims

NOTE: \_\_\_\_\_ (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☐ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: \_\_\_\_\_  
Claim(s) withdrawn from consideration: \_\_\_\_\_

**AFFIDAVIT OR OTHER EVIDENCE**


8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**


11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_

13. ☒ Other: See Continuation Sheet

  
Heather R. Herndon  
Supervisory Patent Examiner  
Technology Center 2100

Quoc A. Tran  
Patent Examiner  
April 30, 2007

  
4/30/2007

Continuation of 13 Other: The Notice of Appeal filed 04-16-2007 and Pre-appeal conf filed 04-27-2007, which are both premature, as the claims have not been twice rejected is Premature.